UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/696,663	10/25/2000	Henry N. Holtzman	PRT-004	4174

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WINTER, JOHN M

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>06 October 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-15</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-15</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1.   Restriction to one of the following inventions is required under 35 U.S.C. 121:

I.   Claims 1-15   are drawn to customer identification, classified in class 705 subclass 1.

II.   Claims 18-31 are drawn to a secure transaction, classified in class 705 subclass 64.

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed in invention I does not require the particulars of the subcombination as claimed in invention II such as a POS device.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). 3.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Via the paper filed on October 6, 2006 the applicant has elected the examination of invention I directed towards claims 1-15.   Affirmation of this election must be made by applicant in replying to this Office action. Claims 29 and 32 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Examiner notes that is would be a burden to search multiple inventions given their separate status in the art as noted above.

The requirement is deemed proper and therefore made FINAL.

Claims 1-15 remain pending.

Response to Arguments

The Applicants arguments filed on October 6, 2006 have been fully considered.

The amended claims a rejected in view of the newly discovered reference Smith et al. (US Patent 6,487,540).

The reference Daly et al. (US Patent 5,878,141) has been withdrawn.
See following rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

Claims 1-5,12 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over
Janning et al. (US patent 6,446,049) in view of Smith et al. (US Patent 6,487,540) and further in
view of Pare, Jr et al. (US Patent 6,662,166).

As per claim 1,
Janning et al. ('049) discloses a computer-based method for selling an item to a customer
at a physical retail location, the method comprising the steps of
receiving at the physical retail location an identifier associated with a token presented by
a customer at the physical retail location;(Column 8, lines 20-28)
preparing the identified customer order at the retail location;(Figure 1)
executing payment by the customer for the selected order by the preferred payment
method;(Column 9, lines 59-67; column 10, lines 1-32)
providing the customer with the selected order at the retail location.(Column 10, lines 35-
38)
Janning et al. ('049) does not explicitly disclose identifying in the customer data a
product order selected by the customer. Smith et al ('540) discloses identifying in the customer
data a product order selected by the customer (column 6, lines 9-34) It would be obvious to one
having ordinary skill in the art at the time of the invention to combine Janning et al.'s method
with Smith et al's teaching of identifying in the customer data a product order selected by the
customer in order to more efficiently serve the customer by offloading the process of receipt
generation to the customers device.
Janning et al. ('049) does not explicitly disclose identifying in the customer data a
preferred payment method for the customer. Smith et al ('540) discloses identifying in the
customer data a preferred payment method for the customer (Column 6 lines 60-67 – column 7,
lines 1-7) It would be obvious to one having ordinary skill in the art at the time of the invention
to combine Janning et al.'s method with Smith et al ('540)l's teaching in order to allow the
customer to budget financial resources.
Janning et al. ('049) does not explicitly disclose accessing customer data from a database
located somewhere other than the token based on the received identifier associated with the
token; Pare Jr. et al ('166) discloses accessing customer data from a database located
somewhere other than the token based on the received identifier associated with the token;

(Column 12, lines 5-23). It would be obvious to one having ordinary skill in the art at the time of the invention to combine Janning et al.'s method with Pare Jr. et al's teaching of accessing customer data in order to more efficiently serve the customer.

As per claim 2,
Janning et al. ('049) discloses the method of claim 1,
wherein the token comprises an RFID tag, and step (a) comprises wirelessly reading a RFID tag presented by the customer.(Column 6, lines 15-42; also figure 1)

As per claim 3,
Janning et al. ('049) discloses the method of claim 2,
wherein the steps are performed in response to a single user action, the single user action comprising presenting the RFID tag to an RFID reader located in the retail location.(Column 8, lines 1-52, also figure 3)

As per claim 4,
Janning et al. ('049) discloses the method of claim 1,
Official notice is taken that it is old and well know in the art of selling an item to a customer at a retail location that the token comprises a magnetic stripe card, and step (a) comprises reading a magnetic stripe card presented by a customer to a magnetic stripe reader. It would be obvious to one having ordinary skill in the art at the time of the invention to utilize a magnetic card and reader because this is an inexpensive well known method of conducting commerce. The examiner notes that this technique is commonly utilized by any credit or ATM card.

As per claim 5,
Janning et al. ('049) discloses the method of claim 4,
Official notice is taken that it is old and well know in the art of selling an item to a customer at a retail location that the steps are performed in response to a single user action, the single user action comprising presenting the magnetic stripe card to a customer accessible magnetic stripe card reader located in the retail location. It would be obvious to one having ordinary skill in the art at the time of the invention that a single user action of presenting a magnetic stripe card to a card reader at a retail location would occur because this is an inexpensive and well known method of conducting commerce. The examiner notes that this technique is commonly utilized by any credit or ATM card.

Claims 6-11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Janning et al. (US patent 6,446,049) in view of Smith et al. (US Patent 6,487,540) and further in view of Pare, Jr et al. (US Patent 6,662,166) and further in view of O'Hagan (US Patent 6,314,406).

As per claim 6,
Janning et al. ('049) discloses the method of claim 1,

Janning et al. ('049) does not explicitly disclose the steps of facilitating customer selection of a product order; and associating the customer selected product order with the customer. O'Hagan et al. ('406) discloses the steps of facilitating customer selection of a product order;(Figure 23) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Janning et al.'s method with O'Hagan et al's teaching of facilitating customer selection of a product order.

Janning et al. ('049) does not explicitly disclose associating the customer selected product order with the customer. Smith et al ('540) discloses associating the customer selected product order with the customer. (column 6, lines 9-34) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Janning et al.'s method with Smith et al's teaching of identifying in the customer data a product order selected by the customer in order to more efficiently serve the customer by offloading the process of receipt generation to the customers device.

As per claim 7,
Janning et al. ('049) discloses the method of claim 6,
Janning et al. ('049) does not explicitly disclose facilitating customer selection via the Internet. O'Hagan et al. ('406) discloses facilitating customer selection via the Internet; (Column 3, lines 16-24) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Janning et al.'s method with O'Hagan et al.'s teaching of facilitating customer selection via the Internet because the internet is an inexpensive and efficient medium to reach the customer.

As per claim 8,
Janning et al. ('049) discloses the method of claim 6,
Official notice is taken that it is old and well know in the art of selling an item to a customer at a retail location to facilitate customer selection at a terminal located in the retail location. It would be obvious to one having ordinary skill in the art at the time of the invention to facilitate customer selection at a terminal located in the retail location because this allows the customer to select items from the immediate inventory of the store and prevents aggravation caused by the necessity to order items.

As per claim 9,
Janning et al. ('049) discloses the method of claim 1,
Janning et al. ('049) does not explicitly disclose accessing customer data over the Internet. O'Hagan et al. ('406) discloses accessing customer data over the Internet; (Column 3, lines 16-24). It would be obvious to one having ordinary skill in the art at the time of the invention to combine Janning et al.'s method with O'Hagan et al.'s teaching of accessing customer data over the Internet because reduces the overhead cost of maintaining the store by reducing the number of database servers needed to complete a transaction

As per claim 10,
Janning et al. ('049) discloses the method of claim 1,

Janning et al. ('049) does not explicitly disclose accessing customer data over a local area network. O'Hagan et al. ('406) discloses accessing customer data over a local area network; (Figure 17) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Janning et al.'s method with O'Hagan et al.'s teaching of accessing customer data over a local area network because reduces the overhead cost of maintaining the store by reducing the number of database servers needed to complete a transaction

As per claim 11,
Janning et al. ('049) discloses the method of claim 1,
Janning et al. ('049) does not explicitly disclose accessing customer data from a local database. O'Hagan et al. ('406) discloses accessing customer data from a local database. (Figure 17) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Janning et al.'s method with O'Hagan et al.'s teaching of accessing customer data from a local database because increased the reliability of the system by allowing information to be accessible even if the network is inoperable.

As per claim 12,
Janning et al. ('049) discloses the method of claim 1,
Official notice is taken that it is old and well know in the art of selling an item to a customer at a retail location to access customer data from a database operated from a third party service provider. It would be obvious to one having ordinary skill in the art at the time of the invention to access customer data from a database operated from a third party service provider because this is a cost effective way to verify the credentials of customer. The examiner notes that this feature is routinely provided by credit rating services such as Equifax.

As per claim 13,
Janning et al. ('049) discloses the method of claim 1,
Janning et al. ('049) does not explicitly disclose providing payment information to a POS device for execution. O'Hagan et al. ('406) discloses providing payment information to a POS device for execution. (Figure 18) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Janning et al.'s method with O'Hagan et al.'s teaching of providing payment information to a POS device for execution because this allows the merchant to realize a profit on the transaction

As per claim 14,
Janning et al. ('049) discloses the method of claim 1,
Official notice is taken that it is old and well know in the art of selling an item to a customer at a retail location to process payment and provide an execution code indicating complete payment to a POS device. It would be obvious to one having ordinary skill in the art at the time of the invention to process payment and provide an execution code indicating complete payment to a POS device because this allows the merchant to realize a profit on the transaction. The examiner notes that this feature is common to a majority POS systems.

As per claim 15,

Janning et al. ('049) discloses the method of claim 1,

Official notice is taken that it is old and well know in the art of selling an item to a customer at a retail location to obtain a count value associated with the token and if the count value is greater than zero, decrementing the count value. It would be obvious to one having ordinary skill in the art at the time of the invention to obtain a count value associated with the token and if the count value is greater than zero, decrement the count value because this encourages the customer loyalty. The examiner notes that this feature is common to promotional sales programs where the customer is "rewarded" after a certain number of purchases are made.

Conclusion

Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.
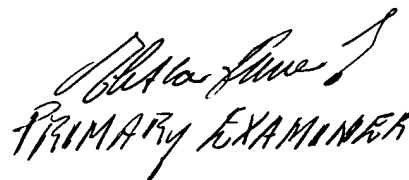
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Winter whose telephone number is (571) 272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

John Winter
Patent Examiner -- 3621

PRIMARY EXAMINER